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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,300	02/26/2002	Naoki Tsuchitou	03500.016242	2783
5514	7590	04/19/2007	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/082,300	TSUCHITOI, NAOKI	
	<b>Examiner</b>	<b>Art Unit</b>	
Peter K. Huntsinger	2625		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 05 February 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5 and 11-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 and 11-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 2/5/07 have been fully considered but they are not persuasive.

The applicant argues on pages 14 and 15 of the response in essence that:

Mori fails to disclose deleting the job at a specific time specified by the user.

- a. Mori '765 disclose the user specifying an amount of elapsed time before the print data is automatically deleted (col. 4, lines 56-65). From the entered elapsed time, the delete time is calculated. Whether the user enters the time as 2 hours from now or as 5:40 PM, both can be considered a specific time.

The applicant argues on pages 15 and 16 of the response in essence that:

Mori fails to disclose deleting the in accordance with a specific condition.

- b. Mori '765 disclose determining if it is the specific time specified by the user, whether each of the print data stored in said storage unit should be deleted in accordance with a specific condition (col. 4, lines 56-65). Whether a delete time has been entered reads on the specific condition, and therefore if a delete time has been entered and it is the specified time, the print data will be deleted.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 16 is seemingly a patentable process, however it is in reality seeking patent protection of the computer program in the abstract as evidenced by claim 22. Claim 16 provides no practical application by physical transformation. Further, because claim 16 is merely a computer program, it does not provide a practical application that produces useful and tangible results. Adding a physical transformation to the language of claim 16 would differentiate the process from a computer program.

Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21 and 22, regardless of being stored in a computer-readable storage medium, claim a control program. Changing the claims to "a computer-readable medium storing a program" would make the claims statutory.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 is seemingly a patentable process, however it is in reality seeking patent protection of the computer program in the abstract as evidenced by claim 21. Claim 24 provides no practical application by physical transformation. Further, because claim 24 is merely a computer program, it does not provide a practical application that produces useful and tangible results. Adding a

physical transformation to the language of claim 24 would differentiate the process from a computer program.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 11-13, 15, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, Jr. et al. Patent 6,535,294 and further in view of Mori Patent 6,089,765.

Referring to claims 1, 11, 21, 23, and 24, Arledge, Jr. et al. disclose a printer controller for controlling printing of print data comprising: a storage unit to store the print data and authentication information corresponding to the print data (Information Database 220 of Fig. 2, col. 9, lines 59-67); an input unit adapted to enable a user to input authentication information to print the print data (Fig. 5, col. 13, lines 15-23); a collation unit adapted to collate the authentication information input by the user with the authentication information stored in said storage unit (col. 13, lines 23-32); a display control unit adapted to, after the user inputs the authentication information, display a list of print data corresponding to the input authentication information on a display panel (Fig. 19, col. 19, lines 1-13); a selection unit adapted to enable the user to select at least one print data from the list of print data displayed on the display panel (col. 19,

lines 11-13); and a control unit adapted to control the printing of the selected print data to be performed after confirming that a print charge for printing the print data selected by the user is paid (col. 21, lines 15-32). Arledge, Jr. et al. do not disclose expressly deleting a job at a user specified time. Mori discloses a check unit adapted to check whether it is a specific time specified by the user (S640 of Fig. 10, col. 14, lines 42-48); a determination unit adapted to determine, if it is the specific time specified by the user, whether each of the print data stored in said storage unit should be deleted in accordance with a specific condition (col. 4, lines 56-65, specific condition is whether a delete time has been entered); and a deletion unit adapted to delete, if there is stored print data which should be deleted, the stored print data which should be deleted (S650 of Fig. 10, col. 14, lines 42-48). Arledge, Jr. et al. and Mori are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to delete a job after a user specified time. The motivation for doing so would have been to delete data that is no longer needed to obtain free storage space. Therefore, it would have been obvious to combine Mori with Arledge, Jr. et al. to obtain the invention as specified in claims 1, 11, and 21.

Referring to claims 2 and 12, Arledge, Jr. et al. disclose print data stored in said storage unit, but do not disclose expressly assigning the print data a priority level. Mori discloses wherein each print data stored in a storage unit is given a priority level, a printer controller further comprising a deletion unit adapted to delete one of the stored print data which is given a low priority level upon detecting that said storage means

cannot store the print data anymore (col. 4-5, lines 66-67, 1-10). Arledge, Jr. et al. and Mori are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to assign a priority level to stored data. The motivation for doing so would have been to delete data that is less important when a storage unit is full. Therefore, it would have been obvious to combine Mori with Arledge, Jr. et al. to obtain the invention as specified in claims 2 and 12.

Referring to claims 3 and 13, Mori discloses wherein the print data which is given the low priority level means the print data which was received earlier than any other print data received by said printer controller (col. 4-5, lines 66-67, 1-10).

Referring to claims 5 and 15, Arledge, Jr. et al. disclose wherein said deletion unit determines that print data should be deleted if a predetermined period has passed after the print data is received by a print controller (col. 4, lines 56-65).

5. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, Jr. et al. Patent 6,535,294 and Mori Patent 6,089,765 as applied to claims 2 and 12 and above, and further in view of Reifman et al. Patent 5,438,433.

Referring to claims 4 and 14, Mori discloses a deletion unit adapted to delete print data, but does not disclose expressly notifying a destination address when print data is deleted. Reifman et al. disclose notification means for notifying a destination address set up when an error occurs (col. 73, lines 64-67). Arledge, Jr. et al. in view of Mori are combinable with Reifman et al. because they are from the same field of printing

systems. At the time of the invention, it would have been obvious to one of ordinary in the art to notifying a destination address when the print data is breached. The motivation for doing so would have been to alert the user when print data is no longer stored and available for printing. Therefore, it would have been obvious to combine Reifman et al. with Arledge, Jr. et al. to obtain the invention as specified in claims 4 and 14.

6. Claims 16-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al. Patent 6,348,972 and further in view of Arledge, Jr. et al. Patent 6,535,294

Referring to claims 16 and 22, Taniguchi et al. disclose a data processing method for providing a print service using an information processing apparatus for storing the print data and authentication information corresponding to the print data, and a printer, comprising: a first transmission step of transmitting authentication information input by a user to print the print data from the printer to the information processing apparatus (S610 of Fig. 6, col. 7, lines 24-27); a display step of displaying a list of print data corresponding to the input authentication information on a display panel of the printer (S606 of Fig. 6, col. 7, lines 1-10); a third transmission step of transmitting at least one print data selected by the user from the list of print data displayed on the display panel from the information processing apparatus to the printer (S612 of Fig. 6, col. 7, lines 34-39); a checking step of checking whether it is a specific time specified by the user (col. 10, lines 9-17); a determination step of determining, if it is the specific

time specified by the user (col. 4, lines 43-49), whether each of the print data stored by the information processing apparatus should be deleted in accordance with a specific condition (col. 10, lines 9-17, whether the job effective term is passed); and a deletion step of deleting, if there is stored print data which should be deleted, the stored print data which should be deleted (col. 10, lines 9-17). Taniguchi et al. do not disclose expressly displaying a list of print data after the user inputs the authentication information and charging for printing. Arledge, Jr. et al. disclose a second transmission step of transmitting information identifying the print data corresponding to the input authentication information (col. 19, lines 1-13); a display step of displaying, after the user inputs authentication information, a list of print data corresponding to the input authentication information on a display panel in accordance with the information transmitted in said second transmission step (Fig. 19, col. 19, lines 1-13); and a control step of controlling the printer to perform the printing of the print data after confirming that a print charge for printing the selected print data is paid (col. 21, lines 15-32). Taniguchi et al. and Arledge, Jr. et al. are combinable because they are from the same field of verifying password authentication in printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display a list of print jobs after a password has been entered and charge for printing. The motivation for doing so would have been to protect information of the user by only providing the print job list after a password has been entered and to collect a fee for a provided service. Therefore, it would have been obvious to combine Arledge, Jr. et al. with Taniguchi et al. to obtain the invention as specified in claims 16 and 22.

Referring to claim 17, Arledge, Jr. et al. disclose the request step of requesting the selected print data of said information processing apparatus after confirming that the print charge for printing the print data selected by the user is paid (col. 21, lines 47-57).

Referring to claim 18, Arledge, Jr. et al. disclose wherein the information identifying the print data is information indicating a name given to the print data corresponding to the input authentication information (col. 13, lines 15-23).

Referring to claim 19, Taniguchi et al. disclose a fourth transmission step of transmitting the information identifying the selected print data from the printer to the information processing apparatus (S608 of Fig. 6, col. 7, lines 11-15) and a fifth transmission step of transmitting the selected print data from the information processing apparatus to the printer based on the information transmitted in said fourth transmission step (S612 of Fig. 6, col. 7, lines 34-39).

Referring to claim 20, Taniguchi et al. disclose a second deletion step of deleting print data printed in said control step from the printer after the end of printing the print data (S615 of Fig. 6, col. 7, lines 49-52).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH  


  
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SUPERVISORY PATENT EXAMINER  
4/6/07